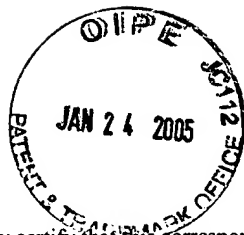


PATENT



MS160277.01/MSFTP168US

AF  
18

CERTIFICATE OF MAILING

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: **Mail Stop Appeal Briefs – Patents**, Assistant Commissioner for Patents, U.S. Patent and Trademark Office, Washington, D.C. 20231.

Date: 1-18-05

Himanshu S. Amin

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:

Applicant(s): Erin M. Bourke-Dunphy, *et al.*

Examiner: Wei Y. Zhen

Serial No: 09/726,000

Art Unit: 2122

Filing Date: November 29, 2000

Title: METHOD AND SOFTWARE TOOLS FOR INTELLIGENT SERVICE PACK  
INSTALLATION

**Mail Stop Appeal Brief – Patents**  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, VA 22313-1450**

---

**AMENDED APPEAL BRIEF**

---

Dear Sir:

Applicants submit this amended brief in connection with an appeal of the above-identified patent application. In response to the Notice of Non-Compliance dated December 21, 2004, Section IV of the brief has been amended to indicate the status of an amendment entered after the Final Office Action. Applicants' representative notes that the Notice of Non-Compliance referred to sections of the Code of Federal Regulations that are no longer in effect. In particular, 37 C.F.R. §1.192, which required that appeal briefs be submitted in triplicate. In compliance with the rule currently in effect, 37 C.F.R. §41.37, one copy of this amended appeal brief is submitted. In the event any additional fees may be due, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [MSFTP168US].

**I. Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))**

The real party in interest in the present appeal is Microsoft Corporation, the assignee of the present application.

**II. Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))**

Appellants, appellants' legal representative, and/or the assignee of the present application are not aware of any appeals or interferences which may be related to, will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. Status of Claims (37 C.F.R. §41.37(c)(1)(iii))**

Claims 1-35 are pending in the application and stand rejected by the Examiner. The rejection of claims 1-35 is being appealed.

**IV. Status of Amendments (37 C.F.R. §41.37(c)(1)(iv))**

An amendment submitted after the Final Office Action was entered by the Examiner. (*See* Advisory Action dated July 9, 2004).

**V. Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))****A. Independent Claim 1**

Independent claim 1 and its corresponding dependent claims relate to a software setup tool for selectively installing service packs in a computer system. (*See e.g.*, Application at p. 4, lines 4-5). The setup tool includes a user interface component that is adapted to prompt a user for desired setup information relating to a desired setup for the computer system and a data store having dependency information. (*See e.g.*, Application at p. 4, lines 5-8). The setup tool also includes a service pack installation component adapted to selectively install at least one service pack associated with at least one application component according to the desired setup information and the dependency information. (*See e.g.*, Application at p. 4, lines 8-14).

**B. Independent Claim 9**

Independent claim 9 and its corresponding dependent claims relate to a method of installing service packs in a computer system. (*See e.g.*, Application at p. 5, lines 1-3). The method entails providing dependency information relating to at least one service pack and prompting a user for desired setup information relating to a desired setup for the computer system. (*See e.g.*, Application at p. 5, lines 3-5). The method also entails selectively installing at least one service pack associated with at least one application component according to the desired setup information and the dependency information. (*See e.g.*, Application at p. 5, lines 5-7).

**C. Independent Claim 22**

Independent claim 22 and its corresponding dependent claims relate to a method of installing service packs in a computer system. (*See e.g.*, Application at p. 5, lines 1-3). The method entails prompting a user for desired setup information relating to a desired setup for the computer system. (*See e.g.*, Application at p. 5, line 5). The method also entails installing a service pack associated with a software component residing in the computer system if the software component requires the service pack and if the desired setup information indicates that an upgrade component corresponding to the software component is not to be installed. (*See e.g.*, Application at p. 5, lines 8-11).

**D. Independent Claim 27**

Independent claim 27 and its corresponding dependent claims relate to computer-readable media having computer-readable instructions. (*See e.g.*, Application at p. 5, lines 18-19). The computer-readable media have computer-readable instructions for prompting a user for desired setup information relating to a desired setup for the computer system. (*See e.g.*, Application at p. 5, lines 19-20). The computer-readable media also have computer-readable instructions for installing a service pack associated with an application residing in the computer system if the application requires the service pack and if the desired setup information indicates that an upgrade component corresponding to the application is not to be installed. (*See e.g.*, Application at p. 5, lines 20-23).

**E. Independent Claim 30**

Independent claim 30 and its corresponding dependent claims relate to a software setup tool for selectively installing service packs in a computer system. (*See e.g.*, Application at p. 5, lines 27-28). The setup tool includes interface means for prompting a user for desired setup information relating to a desired setup for the computer system. (*See e.g.*, Application at p. 14; line 5-30; p. 15, lines 15-17; p. 16, lines 9-12; p. 18, lines 4-19; Fig. 3, element 100; Fig. 4, element 100; Fig. 5, element 202; Fig. 6, element 347). The setup tool also includes means for installing a service pack associated with an application residing in the computer system if the application requires the service pack and if the desired setup information indicates that an upgrade component corresponding to the application is not to be installed. (*See e.g.*, Application at p. 15, lines 20-24; p. 16, lines 16-19 and lines 24-30; p. 17, lines 3-11; p. 18, lines 4-19; and Fig. 5, element 220).

The means for prompting a user and the means for installing a service pack are identified as limitations subject to the provisions of 35 U.S.C. §112 ¶6. The corresponding structures are identified with reference to the specification and drawings in the parentheticals above corresponding to those claim limitations.

**F. Independent Claim 33**

Independent claim 33 relates to a software tool for selectively upgrading at least one application. (*See e.g.*, Application at p. 6, lines 7-8). The software tool includes a component for structuring and installing a service pack installable on a system. (*See e.g.*, Application at p. 6, lines 8-9). The structuring is based at least upon application setup parameters and application dependency parameters. (*See e.g.*, Application at p. 6, lines 9-10).

**G. Independent Claim 34**

Independent claim 34 relates to a system for selectively upgrading at least one application. (*See e.g.*, Application at p. 6, lines 10-11). The system includes a first component for interrogating a system to identify installed software. (*See e.g.*, Application at p. 6, line 12). The system also includes a second component for structuring and installing a service pack installable on the system. (*See e.g.*, Application

at p. 6, line 13). The structuring is based at least upon application setup parameters and application dependency parameters. (*See e.g.*, Application at p. 6, lines 14-15).

#### **H. Independent Claim 35**

Independent claim 35 relates to a data packet adapted to be transmitted between at least two processes. (*See e.g.*, Application at p. 6, lines 15-16). The data packet include a component for structuring and installing a service pack installable on a system. (*See e.g.*, Application at p. 6, lines 16-17). The structuring is based at least upon application setup parameters and application dependency parameters. (*See e.g.*, Application at p. 6, lines 17-18).

#### **VI. Grounds of Rejection to be Reviewed (37 C.F.R. §41.37(c)(1)(vi))**

A. Whether claims 1-14, 17-20, 22-24, and 27-32 are unpatentable under 35 U.S.C. §103(a) over Smith *et al.*, U.S. Patent No. 5,212,631 (“Smith *et al.*”) in view of Beelitz *et al.*, U.S. Patent No. 6,085,263 (“Beelitz *et al.*”);

B. Whether claims 15-16, 20-21, and 25-26 are unpatentable under 35 U.S.C. §103(a) over Smith *et al.* in view of Beelitz *et al.* and further in view of Curtis, U.S. Patent No. 6,442,754 (“Curtis”); and

C. Whether claims 33-35 are unpatentable under 35 U.S.C. §103(a) over Smith *et al.*

#### **VII. Argument (37 C.F.R. §41.37(c)(1)(vii))**

The software setup tools, methods, computer-readable media, systems, and data packets recited in the claims are useful for selectively installing service packs on a computer system. For example, a user may be prompted for desired setup information, and based on the desired setup information, a software setup tool may determine the desired final system state. The software setup tool may then selectively apply service packs as needed in order to install and/or upgrade the desired applications. The software

setup tool thus ensures that the system will be left in an operable state after the upgrading of certain components and installation of one or more service packs, and avoids needless application of service packs. By *automating* this process, the tool reduces the time associated with updating applications.

A. **Rejection of Claims 1-14, 17-20, 22-24, and 27-32 Under 35 U.S.C. §103(a)**

i. **Claims 1-8 and 30-32**

Claims 1-8 and 30-32 are argued separately from the other claims. These claims stand rejected under 35 U.S.C. §103(a) under the contention that these claims are unpatentable over Smith *et al.* in view of Beelitz *et al.* Reversal of this rejection is respectfully requested for at least the following reasons. Neither Smith *et al.* nor Beelitz *et al.*, alone or in combination, teach or suggest all of the claim limitations. In particular, the cited references do not teach or suggest a service pack *installation component*. Thus, the cited references do not teach or suggest the claimed invention as a *whole*.

The test of obviousness is whether "the subject matter sought to be patented and the prior art are such that the subject matter as a *whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art." (*Graham v. John Deere Co.*, 383 U.S. 1, 3 (1966) (emphasis added); *see also e.g., In re Dembiczak*, 175 F.3d 994, 998, 50 U.S.P.Q. 1614, 1616 (Fed. Cir. 1999)). In evaluating obviousness, the PTO must conduct the factual inquiry as outlined in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). (*See In re Lee*, 277 F.3d 1338, 1342-43, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002)). The factual inquiry to be conducted includes determining: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. (*See Graham*, 383 U.S. 1, 17-18 (1966)). The PTO must "not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). The PTO cannot rely merely on conclusory statements and assertions of "common sense" to remedy deficiencies of the cited references. (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434).

Claim 1 recites the limitation a service pack **installation component** adapted to selectively install at least one service pack. Claim 30 recites the limitation **means** for **installing** a service pack. As noted in Section V(E) *supra*, the claim limitation **means** for **installing** a service pack is identified as subject to the provisions of 35 U.S.C. §112 ¶6. As described in the subject patent application, a service pack **installation component** is the structure that corresponds to the function of installing a service pack.

Nowhere in Smith *et al.* is a service pack **installation component** mentioned. The methods taught by Smith *et al.* merely *identify* software patches and generate a list of recommended patches, but do not teach or suggest a service pack **installation component** for installing the patches. (See *e.g.*, Smith *et al.* at Abstract). Once the recommended patches have been identified, the methods of Smith *et al.* require that a user *manually* install the identified patches at some later time. (See *e.g.*, Smith *et al.* at col. 3, lines 32-35; and col. 5, lines 28-29 and lines 53-55). Moreover, the methods of Smith *et al.* require substantial user intervention, for instance to resolve bad patches, structural conflicts, and conflicting patches. (See *e.g.*, Smith *et al.* at col. 2, lines 24-26 and 29-31; and col. 5, lines 49-52). Thus, in the methods of Smith *et al.*, the data accrued in identifying the software patches is utilized by the *user* to resolve conflicts, to decide whether or not to install the patches, and to *manually* install the patches at some later time. (See *e.g.*, Smith *et al.* at col. 2, lines 24-26 and 29-31; and col. 5, lines 49-52). In order to accomplish this, the user would have to know how to resolve conflicts and install patches.

In stark contrast to the *manual* methods taught by Smith *et al.*, the service pack **installation component** recited in the claims **automates** the process of applying setup and dependency information and installing the service packs. (See *e.g.*, Application at p. 3, lines 2-4; and p. 4, lines 8-10). The setup tools ensure that the installation of the service pack is compatible with other applications coexisting on the computer system, and further ensures that the computer system is left in an operable state subsequent to installation of the service pack. This automated process not only has a significant time advantage over the manual interventions taught by Smith *et al.*, automating the process also reduces the need for trained personnel to manually install service packs (as is required in the methods taught by Smith *et al.*).

The Examiner contends that “[a]lthough Smith does not specifically teach the step of installing the service pack, Smith does teach that the service packs are *for* ‘installation on a computer system,’ and hence the service packs are obviously *going to be* installed on a computer system.” (Final Office Action dated April 6, 2004 at p. 3) (emphasis in original) (citation omitted). However, the mere fact that a service pack can be *manually* installed *by a user* at some later date *if* a user decides to install it does not teach or suggest a service pack ***installation component that automates the process***. Moreover, as explained above, automating the process of resolving conflicts and deciding which service packs to install (*i.e.*, ***automating*** selective installation) has significant advantages over the *manual* process taught by Smith *et al.*

Beelitz *et al.* does not make up for the deficiencies of Smith *et al.* The system of Beelitz *et al.* aides a purchaser or designer in the process of gathering information to configure a build-to-order computer system. (*See e.g.*, Beelitz *et al.* at Abstract). The systems of Beelitz *et al.* generate a *list* of user specified hardware and software that is sent to a manufacturing facility. (*See Id.*). The list is then utilized by workers at the manufacturing facility to manufacture a computer system based on the user’s specifications. (*See Id.*).

The Examiner makes conclusory statements regarding Beelitz *et al.* that are not supported by the disclosure. (*See* Final Office Action at pp 3-4). Initially, the Examiner contends that Beelitz *et al.* teaches:

installing a service pack associated with a software component residing in a computer system if the software component requires the service pack. . . . Beelitz teaches installing correctional patches, which are obviously required by some applications to fix critical errors (Column 22, lines 42-52). Beelitz teaches a setup information which indicates application upgrade components to install. The upgrade component that is not to be installed is any upgrade component on the list of setup information that is associated with the application component.

(Final Office Action at pp. 3-4). The text at column 22, lines 42-52 of Beelitz *et al.* (cited to by the Examiner) states:



means for **generating a list** of compatible options that may be implemented on a computer system, each of the compatible options is compatible with a previously selected choice by a user, wherein generating the list of compatible options includes reading the plurality of entries in the computer readable data base, performing a compatibility comparison to determine whether an entry represents an option that is compatible with the previously selected choice, and selecting, from the data base, options that are determined to be compatible with the previously selected choice;

(Beelitz *et al.* at col. 22, lines 42-52) (emphasis added). A means for *generating a list* is not analogous to a service pack **installation component** adapted to selectively **install** service packs. For instance, after the means for generating a list accomplishes its task, a list will be generated. The list will be used by workers at a manufacturing facility at some later time to build a computer according to the specifications provided by the list. In contrast, after a service pack **installation component** for selectively installing service packs has accomplished its task, service packs will be **installed automatically** based on desired setup information and dependency information. The Examiner's conclusory statements fail to establish otherwise. Moreover, in a subsequent section of the Final Office Action, the Examiner concedes that Beelitz *et al.* does *not* teach installing service packs on computer systems as a function of desired setup and dependency information, and that Beelitz *et al.* was not cited for that purpose:

[t]he applicant further argues that Beelitz does **not** teach installing service packs on computer systems as a function of desired setup and dependency information. While this is **true**, this is not the reason that the Beelitz reference is introduced. Beelitz teaches prompting a user for desired setup information, which is an element missing from Smith.

(Final Office Action at p. 6) (emphasis added).

The Federal Circuit has vacated obviousness rejections for lack of an adequate showing that a claim limitation was present in the prior art. (*See In re Thrift*, 298 F.3d 1357, 1365-66, 63 U.S.P.Q.2d 2002, 2006-07 (Fed. Cir. 2002)). *In re Thrift* concerned

claims covering a speech user agent for allowing users to access information located on a computer network. (*Id.* at 1360). One of the claims at issue contained the limitations:

- d. a means for extracting a grammar from a hypermedia source on said information resource for future reference to said source;
- e. a means for modifying said grammar;
- ....
- g. a means for processing said grammar to produce a reference to said hypermedia source.

(*Id.* at 1365). The prior art disclosed all the limitations of the claims except the means for extracting, modifying, and processing grammar. (*Id.* at 1366). The PTO rejected the claim as obvious in light of the prior art contending that "the use of grammar is old and well known in the art of speech recognition as a means of optimization which is highly desirable." (*Id.*). The Federal Circuit vacated the obviousness rejection because the PTO failed to adequately show that *every* claim limitation was present in the prior art. (*See Id.* (citing to *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) and noting that "[w]hile the Examiner's statement generally addresses the use of grammar, it does not discuss the unique limitations of extracting, modifying, or processing the grammar to interact with hypermedia sources. The Board's decision is not supported by substantial evidence because the cited references do not support *each* limitation of claim 11.")) (emphasis added)).

As in *In re Thrift*, the Examiner here has failed to cite prior art that teaches or suggests *every* limitation of the claims. In particular, neither Smith *et al.* nor Beelitz *et al.*, alone or in combination, teach or suggest a service pack *installation component* adapted to selectively install at least one service pack or a *means* for *installing* a service pack. Thus, the cited references do not teach or suggest the claimed invention as a *whole*. In view of at least the foregoing, the subject claims are in condition for allowance and it is respectfully requested that the rejection of claims 1-8 and 30-32 be withdrawn.

ii. **Claims 9-14, 17-20 and 22-24**

Claims 9-14, 17-20 and 22-24 are argued separately from the other claims. These claims stand rejected under 35 U.S.C. §103(a) because the Examiner contends that these

claims are unpatentable over Smith *et al.* in view of Beelitz *et al.* This rejection should be withdrawn for at least the following reasons. Smith *et al.* and Beelitz *et al.*, alone or in combination, fail to teach or suggest all of the claim limitations. In particular, installing a service pack as the term installing is used in the subject patent application. Thus, the cited references do not teach or suggest the claimed invention as a *whole*.

Independent claim 9 is directed towards methods of installing service packs and recites the limitation selectively installing the at least one service pack associated with at least one application component according to the desired setup information and the dependency information. Independent claim 22 recites a similar limitation installing a service pack associated with a software component residing in the computer system if the software component requires the service pack and if the desired setup information indicates that an upgrade component corresponding to the software component is not to be installed. During prosecution, the PTO must give claims the broadest reasonable interpretation in “light of the specification as it would be interpreted by one of ordinary skill in the art.” (*In re Cortright*, 165 F.3d 1353, 1358, 49 U.S.P.Q.2d 1464, 1467 (Fed. Cir. 1999) (citing *In re Bond*, 910 F.2d 831, 833, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990))). The claim term “installing” is used consistently throughout the subject patent application to refer to installation performed by the setup tool (*i.e.*, software). (*See e.g.*, Application at p. 3, lines 8-15; p. 4, lines 3-5 and 17-20; p. 5, lines 27-30; p. 10, lines 23-26; p. 12, lines 7-10 and 20-26; p. 15, lines 1-8; and p. 16, lines 15-19). Nowhere in the subject patent application is the step of selectively installing a service pack performed manually by a user. Indeed, one of the main advantages of the subject invention as recited in the claims is that it *automates* the selective *installation* of service packs and therefore both saves times and minimizes the level of skill a user needs to upgrade applications. Thus, it would be inconsistent with the specification to read the step of installing a service pack as requiring user intervention.

As discussed in Section VII(A)(i) *supra*, Smith *et al.* discloses methods for *identifying* software patches for subsequent *manual* installation by a user and Beelitz *et al.* discloses systems for generating a *list* of hardware and software specifications to guide the subsequent manufacture of a computer system. Neither Smith *et al.* nor Beelitz *et al.*, either alone or in combination, teach or suggest the *automated* selective installation of a service pack by *software*.

For at least the reasons stated in this section and in Section VII(A)(i) *supra*, the Examiner has failed to cite prior art that teaches or suggests *every* limitation of the claims, in particular, installing a service pack as the term installing is used in the subject application. Thus, the cited references do not teach or suggest the claimed invention as a *whole*. In view of at least the foregoing, the subject claims are in condition for allowance and it is respectfully requested that the rejection of claims 9-14, 17-20 and 22-24 be withdrawn.

*iii.      Claims 27-29*

Claims 27-29 are argued separately from the other claims. These claims stand rejected under 35 U.S.C. §103(a) under the contention that these claims are unpatentable over Smith *et al.* in view of Beelitz *et al.* Reversal of this rejection is respectfully requested for at least the following reasons. Neither Smith *et al.* nor Beelitz *et al.*, alone or in combination, teach or suggest all of the claim limitations. In particular, *computer-readable instructions* for *installing* a service pack. Thus, the cited references do not teach or suggest the claimed invention as a *whole*.

Independent claim 27 is directed towards a *computer-readable medium* and recites the limitation *computer-readable instructions* for *installing* a service pack. As discussed in Section VII(A)(i) *supra*, Smith *et al.* discloses methods for *identifying* software patches for subsequent *manual* installation by a user and Beelitz *et al.* discloses systems for generating a *list* of hardware and software specifications to guide the subsequent manufacture of a computer system. Neither Smith *et al.* nor Beelitz *et al.*, alone or in combination, teach or suggest *automating* the installation of service packs using *computer-readable instructions* for *installing* a service pack.

For at least the reasons discussed in this section and Section VII(A)(i) *supra*, the Examiner has failed to cite prior art that teaches or suggests *every* limitation of the claims, in particular, *computer-readable instructions* for *installing* a service pack. Thus, the cited references do not teach or suggest the claimed invention as a *whole*. In view of at least the foregoing, the subject claims are in condition for allowance and it is respectfully requested that the rejection of claims 27-29 be withdrawn.

**B. Rejection of Claims 15-16, 20-21 and 25-26 Under 35 U.S.C. §103(a)**

Claims 15-16, 20-21, and 25-26 stand rejected under 35 U.S.C. §103(a) under the contention that these claims are unpatentable over Smith *et al.* in view of Beelitz *et al.* and further in view of Curtis, U.S. Patent No. 6,442,754 (“Curtis”). Reversal of this rejection is respectfully requested for at least the following reasons. Claims 15-16, 20-21, and 25-26 all depend from one of the independent claims 9 and 22. By virtue of this dependency, these claims contain all of the limitations of the independent claims. All of the independent claims are allowable for at least the reasons stated in Section VII(A)(ii) *supra*. Neither Smith *et al.* nor Beelitz *et al.*, alone or in combination, teach or suggest *every* limitation of the independent claims, notably, installing a service pack as the term installing is used in the subject application. Curtis does not remedy this deficiency and the Examiner does not cite to Curtis for that reason. (See Office Action dated Oct. 6, 2003 at p. 6). Thus, the cited prior art does not teach or suggest the claimed invention as a *whole*. Accordingly, claims 15-16, 20-21, and 25-26 are allowable for at least the same reasons as claims 9 and 22 are allowable. In view of at least the foregoing, the subject claims are in condition for allowance and it is respectfully requested that the rejection of claims 15-16, 20-21, and 25-26 be withdrawn.

**C. Rejection of Claims 33-35 Under 35 U.S.C. §103(a)**

Claims 33-35 stand rejected under 35 U.S.C. §103(a) under the contention that these claims are unpatentable over Smith *et al.* This rejection should be withdrawn for at least the following reason. Smith *et al.* fails to teach or suggest all of the claim limitations. In particular, a *component* for *structuring* and *installing a service pack*. Thus, the cited reference does not teach or suggest the claimed invention as a *whole*.

Independent claims 33-35 recite the limitation a *component* for *structuring* and *installing* a service pack. As explained in Section VII(A)(i) *supra*, a *component* is distinguishable from and has significant advantages over the manual methods taught by Smith *et al.* because it *automates* the selective installation process. Smith *et al.* provides only methods for *identification* of software patches for future *manual* installation by a user if the *user* later decides to install the patches. The methods of Smith *et al.* further require *manual* resolution of conflicts. By *automating* the structuring and installation of a service pack, a *component* for structuring and installing a service pack has significant

advantages over the manual process taught by Smith *et al.*

For at least the reasons discussed in this section and in Section VII(A)(i) *supra*, the Examiner has failed to cite prior art that teaches or suggests *every* limitation of the claims, in particular, a *component* for *structuring* and *installing* a service pack. Thus, the cited reference does not teach or suggest the invention as a *whole*. In view of at least the foregoing, the subject claims are in condition for allowance and it is respectfully requested that the rejection of claims 33-35 be withdrawn.

**D. Conclusion**

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-35 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063[MSFTP168US].

Respectfully submitted,  
AMIN & TUROCY, LLP



Himanshu S. Amin  
Reg. No. 40,894

AMIN & TUROCY, LLP  
24<sup>th</sup> Floor, National City Center  
1900 East 9<sup>th</sup> Street  
Telephone: (216) 696-8730  
Facsimile: (216) 696-8731

**VIII. Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))**

1. A software setup tool for selectively installing service packs in a computer system, comprising:
  - a user interface component adapted to prompt a user for desired setup information relating to a desired setup for the computer system;
  - a data store comprising dependency information; and
  - a service pack installation component adapted to selectively install at least one service pack associated with at least one application component according to the desired setup information and the dependency information.
2. The software setup tool of claim 1, wherein the dependency information comprises information indicative of whether an application residing in the computer system requires the at least one service pack, wherein the setup information comprises information indicative of whether at least one application upgrade component is to be installed, and wherein the service pack installation component is adapted to selectively install the at least one service pack if the dependency information indicates that the application residing in the computer system requires the at least one service pack and the setup information indicates that the at least one application upgrade component is not to be installed.
3. The software setup tool of claim 2, wherein the dependency information comprises information indicative of whether the at least one application upgrade component requires the at least one service pack, and wherein the service pack installation component is adapted to selectively install the at least one service pack if the dependency information indicates that the at least one application upgrade component requires the at least one service pack and the setup information indicates that the at least one application upgrade component is to be installed.

4. The software setup tool of claim 1, wherein the dependency information comprises information indicative of whether at least one application upgrade component requires the at least one service pack, wherein the setup information comprises information indicative of whether the at least one application upgrade component is to be installed, and wherein the service pack installation component is adapted to selectively install the at least one service pack if the dependency information indicates that the at least one application upgrade component requires the at least one service pack and the setup information indicates that the at least one application upgrade component is to be installed.

5. The software setup tool of claim 1, wherein the service pack installation component is adapted to determine the availability of at least one additional service pack associated with one of an application upgrade component and an application residing in the computer system.

6. The software setup tool of claim 5, wherein the service pack installation component is adapted to consult an Internet website to determine the availability of the at least one additional service pack.

7. The software setup tool of claim 1, wherein the user interface component is further adapted to prompt the user to accept or refuse installation of the at least one service pack.

8. The software setup tool of claim 1, wherein the service pack installation component is further adapted to determine whether the at least one application component is installed in the computer system.



9. A method of installing service packs in a computer system, comprising:  
providing dependency information relating to at least one service pack;  
prompting a user for desired setup information relating to a desired setup for the computer system; and  
selectively installing the at least one service pack associated with at least one application component according to the desired setup information and the dependency information.
10. The method of claim 9, further comprising:  
selectively installing at least one application upgrade component in the computer system according to the desired setup information.
11. The method of claim 9, wherein selectively installing the at least one service pack comprises installing the at least one service pack if the at least one application component is installed in the computer system, if the at least one application component requires the at least one service pack, and if the desired setup information indicates that an application upgrade component associated with the at least one application component is not to be installed.
12. The method of claim 11, wherein selectively installing the at least one service pack comprises installing the at least one service pack if the at least one application component is installed in the computer system, if the at least one application component requires the at least one service pack for upgrading, and if the desired setup information indicates that the application upgrade component is to be installed.
13. The method of claim 12, further comprising:  
selectively installing at least one application upgrade component in the computer system according to the desired setup information.
14. The method of claim 12, further comprising determining the availability of at least one additional service pack associated with the at least one application component.

15. The method of claim 14, wherein determining the availability of at least one additional service pack comprises consulting an Internet website to determine the availability of the at least one additional service pack.
16. The method of claim 15, further comprising prompting the user to accept or refuse installation of the at least one service pack.
17. The method of claim 9, wherein selectively installing the at least one service pack comprises installing the at least one service pack if the at least one application component is installed in the computer system, if the at least one application component requires the at least one service pack for upgrading, and if the desired setup information indicates that an application upgrade component associated with the at least one application component is to be installed.
18. The method of claim 17, further comprising:  
selectively installing at least one application upgrade component in the computer system according to the desired setup information.
19. The method of claim 9, further comprising determining the availability of at least one additional service pack associated with the at least one application component.
20. The method of claim 19, wherein determining the availability of at least one additional service pack comprises consulting an Internet website to determine the availability of the at least one additional service pack.
21. The method of claim 20, further comprising prompting the user to accept or refuse installation of the at least one service pack.

22. A method of installing service packs in a computer system, comprising:  
prompting a user for desired setup information relating to a desired setup for the computer system; and  
installing a service pack associated with a software component residing in the computer system if the software component requires the service pack and if the desired setup information indicates that an upgrade component corresponding to the software component is not to be installed.
23. The method of claim 22, further comprising installing the service pack if the upgrade component is to be installed and if the service pack is required for upgrading the software component.
24. The method of claim 23, further comprising selectively refraining from installing the service pack if the upgrade component is to be installed and the service pack is not required for upgrading the software component.
25. The method of claim 24, further comprising prompting the user to accept or refuse installation of the service pack, and refraining from installing the service pack if the user refuses installation of the service pack.
26. The method of claim 22, further comprising prompting the user to accept or refuse installation of the service pack, and refraining from installing the service pack if the user refuses installation of the service pack.
27. A computer-readable medium having computer-readable instructions for:  
prompting a user for desired setup information relating to a desired setup for the computer system; and  
installing a service pack associated with an application residing in the computer system if the application requires the service pack and if the desired setup information indicates that an upgrade component corresponding to the application is not to be installed.

28. The computer-readable medium of claim 27, further comprising computer-readable instructions for installing the service pack if the upgrade component is to be installed and if the service pack is required for upgrading the application.

29. The computer-readable medium of claim 28, further comprising computer-readable instructions for selectively refraining from installing the service pack if the upgrade component is to be installed and the service pack is not required for upgrading the application.

30. A software setup tool for selectively installing service packs in a computer system, comprising:

interface means for prompting a user for desired setup information relating to a desired setup for the computer system; and

means for installing a service pack associated with an application residing in the computer system if the application requires the service pack and if the desired setup information indicates that an upgrade component corresponding to the application is not to be installed.

31. The software setup tool of claim 30, wherein the means for installing a service pack is adapted to install the service pack if the upgrade component is to be installed and if the service pack is required for upgrading the application.

32. The software setup tool of claim 31, wherein the means for installing a service pack is adapted to selectively refraining from installing the service pack if the upgrade component is to be installed and the service pack is not required for upgrading the application.

33. A software tool for selectively upgrading at least one application, comprising:  
a component for structuring and installing a service pack installable on a system, the structuring being based at least upon application setup parameters and application dependency parameters.

34. A system for selectively upgrading at least one application, comprising:  
a first component for interrogating a system to identify installed software; and  
a second component for structuring and installing a service pack installable on the system, the structuring being based at least upon application setup parameters and application dependency parameters.

35. A data packet adapted to be transmitted between at least two processes, comprising:  
a component for structuring and installing a service pack installable on a system, the structuring being based at least upon application setup parameters and application dependency parameters.

**IX. Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))**

None.

**X. Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))**

None.